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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,314	12/20/1999	Yasumasa Yamakoshi	216-429P	2146
2292	7590	08/22/2006		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER ZEMEL, IRINA SOPJIA	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/446,314

Applicant(s)

YAMAKOSHI ET AL.

Examiner

Irina S. Zemel

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/10/06; 3/20/00</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 12-20-99</u>                      |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim 7 has not been further treated on the merits. Note that amendment to the claims filed by the applicants on 2-20-1999 only amended dependency of claim 6 (twice).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The definitions in claim 5 refer to "said dehydrated wet porous crumbs" that appears several times in the claim, and it is unclear and confusing which particle size is measured in respect to which other particle size.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, and 6 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,616,652 to Kusano et al., (hereinafter "Kusano").

Kusano discloses a process for producing dried porous crumbs of hydrogenated block copolymer having less than 1% water, the process includes the steps of providing cyclohexane solution of SEPS with molecular weight of 200,000 (obtained by hydrogenation of SIS), steam stripping the solution to produce water slurry of SEPS, subjecting the slurry to dehydration to reduce the water content to less than 50 %, and exposing the dehydrated wet porous crumbs to hot air in hot plate dryer at temperature of about 120 C which satisfies the claimed limitations as being above 8 C and below 135 C regardless of Mw), in which the dehydrated wet porous crumbs are necessarily is subjected to hot air. See illustrative example 1. The reference further expressly discloses centrifuge an apparatus suitable for the dehydration step, i.e., an apparatus which necessarily employs "centrifugation dehydration" as per claim limitation of step 3. See column 6, lines 63. Further, in addition to teaching hot plate drying apparatus (which, as discuss above necessarily involves subjecting the dried product to hot air at that or around that temperature), the reference expressly teaches suitability of hot blow type dryer for finally drying the dehydrated crumbs to the water content of less than 1 %. See column 7, lines 9-17, especially line 16. The invention as claimed, thus, is fully anticipated by the disclosure of the Kusano reference.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kusano..

The disclosure of the Kusano reference is discussed above.

The reference further disclosed the dried porous crumbs obtained by this method and further discloses oil absorption properties of the crumbs which is given for 3 minute interval rather than 1 minute as claimed in the instant claim 1. However, since it is well known in the art that absorption of oil non-linearly increases with time being greater at the beginning, it is reasonable believed that the crumbs disclosed in the reference and having three times greater absorption at 3 minutes than claimed value at one minute, necessarily inherently exhibit the absorption at least as high as claimed at one minute. The burden is shifted to the applicants to provide factual evidence to the contrary.

The while disclosing a method that is substantially identical to the claimed method reference is silent as to the specific properties such as size and size distribution of the wet and dehydrated porous crumbs as per claims 3-5. However, since the porous crumbs disclosed in the reference are obtained by substantially the same process as the process disclosed and claimed in the instant application, it is reasonably believed that the disclosed crumbs inherently and necessarily exhibit the claimed

properties. . The burden is shifted to the applicants to provide factual evidence to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Irina S. Zemel  
Primary Examiner  
Art Unit 1711

ISZ

